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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/661,927	09/14/2000	William J. Dower	019282-000110US	1158

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EXAMINER

EPPERSON, JON D

ART UNIT	PAPER NUMBER
1639	

DATE MAILED: 11/13/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

SUPPLEMENTAL RESTRICTION

Please Note: In an effort to enhance communication with our customers and reduce processing time, Group 1627 is running a Fax Response Pilot for Written Restriction Requirements. A dedicated Fax machine is in place to receive your responses. The fax number is (703) 308-4315. A fax cover sheet is attached to this Office Action for your convenience. We encourage your participation in this Pilot program. If you have any questions or suggestions please contact Jyothsna Venkat, Supervisory Patent Examiner, at (703) 308-2439. Thank you in advance for allowing us to enhance our customer service. Please limit the use of this dedicated Fax number to responses to Written Restrictions.

1. The Response to Restriction Requirement and Preliminary Amendment filed on September 16, 2002, is acknowledged (Paper No. 11).

2. The reply dated September 16, 2002 (Paper No. 11) is not fully responsive to the prior Office action because of the following omission(s) or matter(s):

Applicants failed to make all of the species requirements stated in the Restriction (see Paper No. 10, paragraph 13, subgroups 5-8). For example, applicants did not elect a single species of ligand. Applicants' election is not in compliance because applicants elected "small molecules" which encompasses an infinite number of compounds.

Applicant must elect a single species of ligand. Furthermore, applicants did not elect a single species of complex. Applicants elected a complex wherein the compound, reporter and linker were designated as "small molecules", "a dye that can interact with an intracellular agent", and a "photocleavable linker", respectively. Again, this election reads on an infinite number of compounds. Applicants must elect a single species of complex, wherein applicants designate a single compound, reporter and linker. To insure

compliance, applicants must set forth a specific structure for said complex, which clearly shows all of the atoms and bonds that are necessary to define the complex including the compound, reporter and linker. Applicant should not use notations like X or R when identifying the elected structure because these letters represent groups with variable members and, as a result, more than one species would be erroneously elected. Furthermore, applicant must indicate which claims read on the elected species i.e., which claims read only on the elected species.

3. Furthermore, upon further review of applicant's claims, an additional restriction and/or election was deemed necessary as outlined below.
4. All traversals will be addressed in the first action on the merits.

Additional Election of Species

5. Upon review of the instant case, the application was deemed to contain claims directed to additional patentably distinct species of the claimed invention. Election from the following species is required.

Subgroup A: Species of carrier-type transport protein (see claim 1)

Applicant must elect, for the purposes of search, a single species of carrier-type transport protein. Furthermore, applicant must indicate which claims read on the elected species i.e., which claims read only on the elected species of subgroup A.

6. The species are distinct, each from the other, because their structures and modes of action are different. They would also differ in their reactivity and the starting materials from which they are made. For different species of method, the method steps for each species would differ. Moreover, the above species can be separately classified. Consequently, the species have different issues regarding patentability and represent patentably distinct subject matter. Therefore, this does create an undue search burden, and election for examination purposes as indicated is proper.

7. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable.

8. Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

9. Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

10. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

11. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.43). Because the above restriction/election requirement is complex, a telephone call to applicants to request an oral election was not made. See MPEP § 812.01.

12. Applicant is reminded that upon cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

13. Applicant is also reminded that a 1 – month (not less than 30 days) shortened statutory period will be set for response when a written requirement is made without an action on the merits. This period may be extended under the provisions of 37 CFR 1.136(a). Such action will

not be an "action on the merits" for purposes of the second action final program, see MPEP 809.02(a).

Conclusion

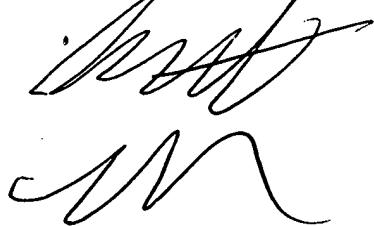
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jon D Epperson whose telephone number is (703) 308-2423. The examiner can normally be reached Monday through Friday from 8:30 a.m. to 4:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Wang, can be reached on (703) 306-3217. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-2439.

Jon D. Epperson, Ph.D.
November 8, 2002

BENNETT CELSA
PRIMARY EXAMINER

The image contains two handwritten signatures. The top signature is "BENNETT CELSA" followed by "PRIMARY EXAMINER". The bottom signature is "JON D. EPPERSON".

